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Jennifer D. Ahearn
Jennifer Ahearn

GP 3728 AR ✓

PATENT
Atty. Docket No. 31045-00007

#9
Brief
E. J. J. J.
10/19/00

**In the United States Patent and Trademark Office
Before the Board of Patent Appeals and Interferences**

In re Application of:

ALBERT SILVERA

Serial No.: 09/268,412

Filed: March 15, 1999

For: TECHNIQUE FOR DECORATING A SHOE AND
A SHOE DECORATED USING THE
TECHNIQUE

Group Art Unit: 3728

Examiner: J. Mohandesi

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

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TC 3700 MAIL ROOM

**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 C.F.R. § 1.192)**

Sir:

Transmitted herewith, in triplicate, is the Appeal Brief in the above-referenced patent application, with respect to the Notice of Appeal filed on July 11, 2000.

This Appeal Brief is being submitted on behalf of Assignee, Dyanasty Footwear, Ltd., a corporation other than a small entity.

U.S. Serial No. 09/268,412


Pursuant to 37 C.F.R. § 1.17(f) enclosed please find a check in the amount of \$310.00 to cover the filing fee for the Appeal Brief. If any additional fees are due for the filing or the Appeal Brief, the Commissioner is authorized to charge them to Deposit Account No. 13-3735.

Respectfully submitted,

MITCHELL, SILBERBERG & KNUPP LLP

Dated: October 11, 2000

By


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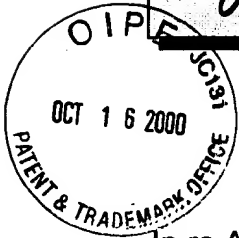
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#9 Appeal Brief

PATENT
Atty. Docket No. 31045-7

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APPELLANT'S BRIEF
ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

Appellant in the above-captioned patent application appeals the final rejection of claims 1, 2, 4 to 9, and 11 to 19 set forth in the Office Action mailed April 13, 2000, a timely Notice of Appeal having been filed on July 11, 2000 and received by the PTO on July 17, 2000.

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I. REAL PARTY IN INTEREST

The real party in interest in this application is Dynasty Footwear, Ltd., having a place of business at 800 N. Sepulveda Blvd., El Segundo, California 90245-2702, pursuant to an assignment which was recorded at reel 9834, frame 0105 on March 15, 1999.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1, 2, 4 to 9, and 11 to 19 have been finally rejected and are the subject matter of this appeal. Claims 3, 10 and 20 have been canceled. In accordance with 37 C.F.R. § 1.192(c)(9), a copy of the claims involved in this appeal is included in the Appendix attached hereto.

IV. STATUS OF THE AMENDMENTS

An Amendment After Final Rejection, canceling dependent claims 10 and 20 and incorporating their subject matter into independent claims 1 and 11, was filed on September 11, 2000. In the Advisory Action dated September 20, 2000, the Examiner indicated that these amendments would be entered upon the filing of a Notice of Appeal and an Appeal Brief. Accordingly, these amendments are reflected in the attached Appendix.

V. SUMMARY OF THE INVENTION

The present invention is directed to decorating shoes, such as sports shoes or children's shoes, and is specifically concerned with decorating a shoe with stick-on tattoos.

It is quite common for manufacturers to include various decorative designs on the shoes that they manufacture. Unfortunately, most such designs are permanently printed or sewn onto the shoe. As a result, in order to display a different design, a customer typically must purchase a different shoe bearing the desired design. Clearly, this can be costly and often impractical.

Responding to the problem, various approaches have been proposed to provide shoes having decorations that can be customized by the end user. In one, adhesive-backed stickers are applied to a shoe. Unfortunately, such stickers usually cannot be easily removed from the shoe, thus often resulting in a permanent decoration of the shoe once applied. In addition, the adhesive used on such stickers may even damage the shoe.

In another approach, decorative elements are attached to a shoe using a hooked material on the decorative elements and a looped material on the shoe (commonly known under the trademark Velcro). While allowing for the possibility of subsequent alterations of the decorative arrangement, this approach has its own problems. For instance, use of Velcro generally means that the decorative article will protrude somewhat from the surface of the shoe, thus increasing the likelihood that the decorative article will be pulled off if another object rubs against the shoe. In addition, use of a Velcro fabric on a shoe often will tend to trap lint and other unwanted materials, making it difficult to keep the shoe clean.

The present invention addresses the foregoing problems by providing a shoe decorating technique and a decorated shoe in which a stick-on tattoo that does not include separate adhesive material is applied to a smooth outer surface of the shoe. See Figure 2, reference number 102; page 7, lines 12 to 15; and page 7, lines 20 to 21, of the Specification. By using such a stick-on tattoo as the decorative article and applying the tattoo to a smooth outer portion of the shoe in this manner, the present invention allows a shoe to be decorated and re-decorated with relatively little effort,

while typically insuring that the decorative article remains on the shoe until it is desired to be removed. At the same time, a shoe decorated according to the present invention generally will be easier to keep clean than a shoe that requires a Velcro surface.

It is noted that a variety of "stick-on tattoos" are available commercially. Some, such as those described in U.S. Patent 5,421,765 (Lehmann), use adhesive backing and therefore are simply one type of what is commonly known as a sticker. Another class of stick-on tattoos, those used in the present invention, do not rely upon separate adhesive backing. These types of tattoos typically adhere by taking advantage of the different properties that the tattoo material exhibits when wet, as compared with the material's dry state. Because no adhesive is used, the types of materials to which such tattoos will reliably adhere often is much more limited than is the case with adhesive-backed tattoos. Moreover, of those materials to which such non-adhesive tattoos will so adhere, the number of materials from which such tattoos may be removed with relative ease when desired is even more limited. As a result, the use of such non-adhesive-backed tattoos conventionally has been limited to mainly to application to skin.

Nevertheless, Appellant has discovered that such a non-adhesive-backed tattoo can be effectively applied to a shoe and then later relatively easily removed if a sufficiently smooth surface is provided. At the same time, any potentially damaging or toxic effects of using a tattoo having separate adhesive material can be avoided.

In the present invention, the smooth surface to which the stick-on tattoo is attached preferably is comprised of polyvinyl chloride (page 5, lines 17 to 19), but in any event preferably allows the stick-on tattoo to be removed with no more than moderate effort by only scratching with a fingernail, even after adhering to the shoe for more than one month (page 8, lines 4 to 8). In other aspects of the invention, the smooth surface to which the stick-on tattoo is applied is either clear or white (page 5, lines 21 to 23), thereby allowing better visibility of the stick-on tattoo.

VI. ISSUES PRESENTED ON APPEAL

The issues are whether claims 1, 2, 5, 7 to 9, and 11 are properly rejected under 35 U.S.C. § 103(a) over U.S. Patent 5,421,765 (Lehmann) in view of U.S. Patent 5,290,043 (Vidinic); whether claims 1, 2 and 4 to 9, and 11 are properly rejected under 35 U.S.C. § 103(a) over Lehmann in view of U.S. Patent 5,136,726 (Kellin); and whether claims 11 to 19 are properly rejected under 35 U.S.C. § 103(a) over French Patent Application 764,103 (Penataro) in view of Lehmann.

VII. GROUPING OF THE CLAIMS

In the Office Action, the Examiner grouped the claims in a particular manner. However, upon reviewing Lehmann, Vidinic, Kellin and Penataro, as well as the grounds for rejection set forth in the Office Action, Appellant has determined that the claims are more appropriately grouped as follows:

GROUP 1: Claims 1 , 5 to 7, 11 and 18

GROUP 2: Claim 2 and 16

GROUP 3: Claims 4 and 15

GROUP 4: Claim 8

GROUP 5: Claims 9 and 19

GROUP 6: Claims 12 to 14

GROUP 7: Claim 17

As explained below, each of the above groups is believed to be separately patentable over the applied art. In particular, each identified group recites at least one additional, non-obvious feature that provides an additional reason why each claim in such group is not rendered obvious by the applied art.

VIII. ARGUMENT

DISCUSSION OF ISSUES ON APPEAL

The requirements for establishing a *prima facie* case for a § 103 rejection have been stated as follows.

“a proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. [citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 U.S.P.Q.2D 1529, 1531 (Fed. Cir. 1988).] Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.”

In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991).

Thus, MPEP § 2142 requires that in order to establish a *prima facie* case of obviousness, the Examiner must cite prior art references that teach or suggest all of the claim limitations and, if more than one such reference is required to disclose all such limitations, there must be some suggestion or motivation, either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings.

As discussed below, the above requirements for establishing a *prima facie* case of obviousness have not been met for any of the following groups of claims.

Group 1 Claims

Claims 1 and 5 to 7 are directed to decorating a shoe by wetting a stick-on tattoo and applying the stick-on tattoo to a smooth outer surface of the shoe, in which the stick-on tattoo does not include separate adhesive material. Claims 11 and 18 are directed to a decorated shoe with a stick-on tattoo attached to a smooth portion of the

outer surface of the shoe, in which the stick-on tattoo does not include separate adhesive material.

The applied art does not disclose or suggest at least the feature of a stick-on tattoo that does not include separate adhesive material adhering to a smooth outer surface of a shoe. In this regard, the Examiner has rejected the Group 1 claims over various combinations of Lehmann, Vidinic, Kellin and Penataro. Each of these references is discussed below.

Lehmann only discusses applying an adhesive-backed tattoo (in the nature of a sticker) to clothing, skin, hair or toys. Specifically, lines 3 to 8 of Lehmann's Abstract and column 3, lines 3 to 6, of Lehmann's Specification clearly state that his tattoos are adhesive-backed. Moreover, Lehmann says nothing at all about applying any other type of tattoo to a shoe.

Vidinic discusses applying articles to shoes, but appears only to contemplate attaching Velcro-backed patches or adhesive-backed stickers. See column 3, lines 32 to 34.

Kellin discusses placing detachable decorative elements on different articles of apparel, such as boots, shoes, caps, belts and backpacks. However, Kellin's decorative articles are attached using Velcro. Specifically, in Kellin substantially all exposed cloth surfaces of the articles of apparel are made of a stretchable "loop" fabric (column 2, lines 60 to 62), thereby permitting decorative articles having a "hooked" backing to be applied to such apparel (column 3, lines 57 to 60).

Penataro only appears to disclose use of a protective strip on a shoe. Therefore, Penataro is not believed to be applicable to the present invention at all.

As a result, none of Lehmann, Vidinic, Kellin or Penataro discloses or suggests a stick-on tattoo that does not include separate adhesive material adhering to a smooth outer surface of a shoe. In fact, the applied art does not discuss any use at all of a stick-on tattoo that does not include separate adhesive material.

As noted above, in order to establish a *prima facie* case of obviousness, it must first be shown that the applied art discloses or suggests all features of the claimed

invention. However, the applied art clearly does not show at least the above-referenced feature of the invention. Accordingly, it is not believed that any permissible combination of the applied art would have rendered the Group 1 claims obvious.

Claims 1, 5 to 7, 11 and 18 are therefore believed allowable over the applied art.

Group 2 Claims

Claims 2 and 16 depend from claims 1 and 11, respectively, and recite the further limitation that the stick-on tattoo is comprised of a combination of a copolymer and a polyester resin. As apparently acknowledged in the Office Action, this limitation is not disclosed or suggested by the applied art. Instead, as to these claims, it is asserted in the Office Action that it would have been obvious to modify the material of the tattoos described in Lehmann, the stickers described in Vidinic or the protective strip described in Penataro as an obvious design choice or as a matter of routine optimization, "since it would appear they would work equally well in any of a variety of sizes, shapes or materials". However, there is no support presented in the Office Action for this assertion.

As noted above, in order to establish a *prima facie* case of obviousness, the Examiner must cite prior art references that disclose or suggest all features of the claimed invention. However, nothing in the applied art indicates that comprising Lehmann's or Vidinic's adhesive-backed stickers, or Penataro's protective strip, of a combination of a copolymer and a polyester resin would have been an obvious design choice or would have somehow optimized those items.

It is therefore believed that a *prima facie* case of obviousness has not been made out with respect to the Group 2 claims.

Claims 2 and 16 are therefore believed to be allowable over the applied art.

Group 3 Claims

Claims 4 and 15 depend from claims 1 and 11, respectively, and recite the further limitation that the smooth portion of the outer surface of the shoe is comprised of

polyvinyl chloride (PVC). This limitation is not disclosed or suggested by the applied art.

At the outset, it is noted that very few shoes have outer surfaces comprised of PVC. Therefore, without some specific motivation, it is not believed that one would seek out a PVC surface for application of stick-on tattoos. In this regard, Lehmann does not appear to be very particular about to what surfaces his tattoos are applied, and certainly does not suggest applying them to an outer surface of a shoe comprised of PVC. Similarly, neither Vidinic, Kellin or Penataro says anything at all about application of stick-on tattoos to a PVC surface of a shoe. Thus, it is believed that none of the applied art would have disclosed or suggested this feature of the invention.

In view of this deficiency, the Examiner merely asserts that the shape, size and make of the shoes is entirely a design choice. However, once again no reference has been cited to support this assertion. It is therefore believed that a *prima facie* case of obviousness has not been made out with respect to claims 4 and 15.

For these additional reasons, claims 4 and 15 are believed to be allowable over the applied art.

Group 4 Claim

Claim 8 depends from claim 1 and recites the further limitation that the stick-on tattoo can be removed with no more than moderate effort by only scratching with a fingernail even after adhering to the shoe for more than one month. This limitation is not disclosed or suggested in the applied art. In fact, the Examiner has not even alleged that the applied art shows this feature of the invention. For this additional reason, claim 8 is believed to be allowable over the applied art.

Group 5 Claims

Claims 9 and 19 depend from independent claims 1 and 11, respectively, and recite the further limitation that the stick-on tattoo is comprised of a film-like material. This feature is not disclosed or suggested by the applied art. Instead, the Examiner merely concludes that it would have been obvious to modify the material of the tattoos

described in Lehmann or the stickers in Vidinic as an obvious design choice or as a matter of routine optimization "since it would appear that they would work equally well in any of a variety of sizes, shapes or materials". However, no prior art reference has been cited in the Office Action to support this assertion. As a result, it is believed that a *prima facie* case has not been made out with respect to the Group 5 claims.

For this additional reason, claims 9 and 19 are believed to be allowable over the applied art.

Group 6 Claims

Claims 12, 13 and 14 depend from claim 11 and recite the further limitations that the shoe includes a recessed portion and that the smooth portion of the outer surface of the shoe is disposed within the recessed portion. This feature is not disclosed or suggested by the applied art.

The Examiner has cited a combination of Penataro and Lehmann as showing this feature of the invention. Specifically, the Examiner alleges that Penataro "teaches placing an ornamental strip in a recess with a smooth surface of the shoe." However, Penataro's drawing merely shows a shoe with a strip attached along the bottom of its sole. The purpose of the strip is unclear, although presumably it is to protect the shoe.

Penataro's drawing does not indicate that his strip is disposed within a recessed portion of the shoe or that the strip is attached to a smooth portion of the outer surface of the shoe, as in the present invention. Moreover, the Office Action has pointed to no other portion of the applied art that shows either of these features of the invention.

Also, even if Penataro had shown attaching a strip within a smooth surface within a recessed portion of the outer surface of a shoe (and it clearly does not), there is simply no motivation to combine Penataro and Lehmann as suggested in the Office Action. Specifically, if the primary purpose of Penataro's strip is to protect the shoe, there would have been no motivation to substitute a thin adhesive-backed sticker for such a strip. In fact, such a substitution clearly would have been contrary to the main purpose for providing the strip.

For these additional reasons, claims 12 to 14 are believed to be allowable over the applied art.

Group 7 Claim

Claim 17 depends from independent claim 11 and recites the further limitation that the smooth portion of the outer surface of the shoe approximately matches the stick-on tattoo in size. This feature is not disclosed or suggested by the applied art. Instead, the Examiner merely concludes that "it would have been obvious to modify and/or alter the shape and size of the recess portion and smooth portion in order to fit the decorative strip more securely and/or as an obvious choice of design or as a matter of routine optimization since it would appear that they would work equally well in any of a variety of sizes or shapes". However, no prior art reference has been cited in the Office Action to support this assertion. As a result, it is believed that a *prima facie* case has not been made out with respect to the Group 7 claim.

For this additional reason, claim 17 is believed to be allowable over the applied art.

CONCLUDING REMARKS

As Appellant has shown above, for a number of reasons, nothing in the cited references discloses, teaches, or suggests the inventions recited by the claims on appeal. Appellant therefore respectfully submits that the claimed invention is patentably distinct over the applied art.

Serial No.: 09/268,412

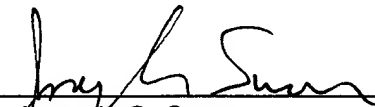
In view of the foregoing, Appellant respectfully requests that the rejection of claims 1, 2, 4 to 9, and 11 to 19 be reversed and a Notice of Allowance issued.

Respectfully submitted,

MITCHELL, SILBERBERG & KNUPP LLP

Dated: October 11, 2000

By


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APPENDIX

Claims on Appeal

1. A method for decorating a shoe, comprising:
wetting a stick-on tattoo; and
applying the stick-on tattoo to a smooth portion of an outer surface of the shoe,
wherein the stick-on tattoo does not include separate adhesive material, and
wherein the stick-on tattoo is applied to the shoe without using separate adhesive material.
2. A method according to claim 1, wherein the stick-on tattoo is comprised of a combination of a copolymer and a polyester resin.
3. CANCELED
4. A method according to claim 1, wherein the smooth portion of the outer surface of the shoe is comprised of polyvinyl chloride (PVC).
5. A method according to claim 1, further comprising steps of removing the stick-on tattoo from the shoe and applying a second stick-on tattoo to the shoe.
6. A method according to claim 1, wherein the stick-on tattoo is applied to a portion of the outer surface of the shoe that is white.
7. A method according to claim 1, wherein the stick-on tattoo is applied to a portion of the outer surface of the shoe that is clear.
8. A method according to claim 1, wherein the stick-on tattoo can be removed with no more than moderate effort by only scratching with a fingernail even after adhering to the shoe for more than one month.
9. A method according to claim 1, wherein the stick-on tattoo is comprised of a film-like material.
10. CANCELED
11. A decorated shoe, comprising:
a shoe having an outer surface which includes a smooth portion; and
a stick-on tattoo attached to the smooth portion of the outer surface of the shoe,
wherein the stick-on tattoo does not include separate adhesive material and
adheres to the shoe without use of separate adhesive material.
12. A decorated shoe according to claim 11, further comprising a recessed portion,
wherein the smooth portion of the outer surface of the shoe is disposed within the recessed portion.

Serial No.: 09/268,412

13. A decorated shoe according to claim 12, wherein the recessed portion has an average width of at least 1.2 centimeters.
14. A decorated shoe according to claim 12, wherein the recessed portion has a surface area in excess of 10 square centimeters.
15. A decorated shoe according to claim 11, wherein the smooth portion of the outer surface of the shoe is comprised of polyvinyl chloride (PVC).
16. A decorated shoe according to claim 11, wherein the stick-on tattoo is comprised of a combination of a copolymer and a polyester resin.
17. A decorated shoe according to claim 11, wherein the smooth portion of the outer surface of the shoe approximately matches the stick-on tattoo in size.
18. A decorated shoe according to claim 11, wherein the smooth portion of the outer surface of the shoe is stitched into the outer portion of the shoe.
19. A decorated shoe according to claim 11, wherein the stick-on tattoo is comprised of a film-like material.
20. CANCELED